



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,584	07/19/2000	Jean-Michel Bernardon	016800-390	1988

21839 7590 03/04/2002

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

QAZI, SABIHA NAIM

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/619,582

Applicant(s)
Bernarden et al.

Examiner
Sabiha Qazi

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 1, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, and 16-23 is/are rejected.
- 7) ☒ Claim(s) 14, 15, and 24-32 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Final Office Action on Merits

Claims 12-32 are pending.

Claims 14-15 and 24--32 are objected.

Claims 12, 13 and 16-23 are rejected.

No claim is allowed. Invention was examined to the extent of elected invention. Others are withdrawn from consideration as non elected invention.

Response filed in paper no. 13, dated 2/1/02 is hereby acknowledged. Rejection under 112 (2) is withdrawn because claims are amended. For other claims arguments were fully considered but are not found persuasive therefore, rejections mailed in paper no. 10 are maintained for the same reasons. Non elected invention is not canceled. For example claim 31 and 32 contain compound which is non elected. It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action. Elected invention is drawn to compounds and composition. Claims 14, 15 and 24-27, 29-32 are objected to for containing non elected invention. When Ar is © or (d) was examined in this application. The argument that in claim 1, compounds are disclosed, there is no claim 1 in this application now. Claims 1-11 were cancelled and new claims 12-32 were added, see preliminary amendment filed in paper no. 3, dated 7/19/00.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12, 13, 19, 20, 21, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Obushak, N. D. Et al. (DN 113:152173, HCAPLUS; Abstract of Zh. Org. Khim. (1990), 26(4), 873-80). See abstract and compound of RN 62806-31-9P .
2. Claims 12, 13, 19, 20, 21, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Krutosikova, A. et al. (DN 84:58390, HCAPLUS; abstract of Collect. Czech., Chem. Commun. (1975), 40(11), 3362-9). See abstract and compound of RN58110-44-4 and 58110-55-7P.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Basis of Rejection

The method of use and pharmaceutical compositions for the use to treat various kinds of diseases is broad. Specification does not support the use of the compounds for variety of diseases listed in claims.

For example the terms "cancerous and precancerous disease conditions" in claims is broad and specification is not enabled for the treatment of all the diseases as claimed.

There is no drugs which is broadly effective against all forms of cancer, (see Carter S.K. et al. Chemotherapy of Cancer, pages 364 and 365; second edition, John Wiley & sons, New York, 1981, appendix C). See table on pages 364 and 365 where the interaction of different drugs on various type of cancer are listed. It is clear from the data that each drug has different interactions with different types of tumors i.e. one drug cannot treat all type of cancer.

The claims should be limited to certain types of cancer which is supported in specification.

For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered [In re Wands, 8 USPQ2d 1400, 1404 (CAFC, 1988)]:

- 1) Breadth of claim
- 2) Nature of invention.
- 3) State of prior art.
- 4) Level of ordinary skill in the art.
- 5) Level of predictability in the art.
- 6) Amount of direction and guidance provided by the inventor.
- 7) Existence of working examples.
- 8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

1) The nature of the invention:

1) The nature of the invention: The invention is directed to compounds and method of treatment of various kind of diseases for example treatment of insulin dependent diabetes, arteriosclerosis, cancerous and precancerous states, arthritis, hypertension etc. (Listed in claim 18).

2) The predictability or lack thereof in the art: There is a general lack of predictability in the pharmaceutical art. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970).

Claims are drawn to the treatment of cancerous disease and precancerous disease along with a list of diseases said to be useful for the treatment by the instant compounds.

The specification does not provide enablement for the treatment of cancer generally. No compound has ever been found that can treat cancers generally even though massive efforts have been directed towards this end.

Nearly all anticancer drugs are effective against only a limited group of related cancers. Therefore, a compound effective against cancer generally would be a revolutionary exception.

3) The amount of direction or guidance present: The disclosure does not describe the method of use of the compounds of the instant invention for the treatment of various types of diseases as for example described in claim 18 and other claims. How precancerous condition can be treated?. There is no support for all the cancerous diseases as claimed.

4) The quantity of experimentation needed: Since the are of unknown breadth and since there is a lack of a guidance present in the specification, the skilled artisan would have to undertake undue experimentation to practice the claimed invention commensurate with the scope of the claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Sabiha N. Qazi, Ph.D.

Primary Examiner

Art Unit 1616

2/14/02